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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/342,719 06/29/99 ROE

D 75900

EXAMINER

QM12/0116

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SHANOSKI, P

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

01/16/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/342,719

Applicant(s)

ROE ET AL.

Examiner

Paul A Shanoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-27, 38-39, 45-46, 50-57, and 61-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) claims 28-37, 40-44, 47-49, and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 8.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**GLENN K. DAWSON**  
**PRIMARY EXAMINER**

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21 and 50-57 and 61-63, drawn to an absorbent article having a feces modifying agent, classified in class 604, subclass 367.
- II. Claim 22, drawn to an absorbent article having a waste management element having specific acceptance under pressure values, classified in class 604, subclass 385.01.
- III. Claims 23-27, drawn to an insert to be placed within an absorbent garment, classified in class 604, subclass 367.
- IV. Claims 28-49 and 58-60, drawn to a method of using an article, as well as the article itself, having specific waste contamination areas and masses, classified in class 604, subclass 385.01.

The inventions are distinct, each from the other because of the following reasons: the first group deals with an article containing a fecal modifying agent, whereas the second deals with an article having a particular test characteristic when subjected to the test which measures acceptance under pressure values, the third concerns an insert which is intended to be used in conjunction with an article, and the fourth concerns an article which has particular areas and masses for waste contamination. Each of these four inventions is believed to be patentably distinct.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III, or IV, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Concerning group I above, there are 6 sub-groups within this group: claims 2 and 51, a viscosity decreasing agent; claims 3-10 and 52, a water liberating agent; claims 11-16 and 54, a viscosity increasing agent; claims 17 and 55, a fecal modifying agent which reduces the hardness of the feces; claim 18, a fecal modifying agent which increases the hardness of the feces, and; claim 53, a calcium based modifying agent.

Concerning group III above, there are 3 sub-groups within this group: claim 24, a viscosity decreasing agent; claim 25, a feces water-liberating agent, and; claim 26, a viscosity increasing agent.

Concerning group IV above, there are 5 sub-groups within this group: claim 38, a viscosity decreasing agent; claim 39, a feces water-liberating agent; claims 40-44, viscosity increasing agent; claim 45, an agent which reduces the hardness of the feces, and; claim 46, an agent which increases the hardness of the feces.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with David Weirich on 1/8/2001 a provisional election was made without traverse to prosecute the invention of Group IV, claims 28-37, 40-44, 47-49, and 58-60. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-27, 38-39, 45-46, 50-57, and 61-63 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Shanoski whose telephone number is (703) 305-0560. The examiner can normally be reached on M-F, 7:30-4.

### ***Information Disclosure Statement***

Information Disclosure Statements, papers no. 4 and 6-8 have been considered.

The information disclosure statement filed 10/25/1999, paper no. 5, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

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(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because in Table VIII, found on page 55 of the specification, there are no units associated with the heading "Waste Contamination Mass (mass units)". The same is true of the Excel chart found on pages 76-77. The Applicant sets forth in the specification a test for measuring the Waste Contamination Mass via the use of a wiping sled, but fails to set forth any units. As one of ordinary skill in the art would not be able to determine what amount of material was determined to be present on the wipe after wiping, the units are essential to the practice of this invention.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28-37, 40-44, 47-49, and 58-60 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The claims recite the limitation "Waste Contamination Mass of less than about 14 mass units", but fail to set forth whether this mass unit is grams, pounds, ounces, etc. The units are critical or

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essential to the practice of the invention, but are not included in the claims and is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Applicant sets forth in the specification a test for measuring the Waste Contamination Mass via the use of a wiping sled, but fails to set forth any units. As one of ordinary skill in the art would not be able to determine what amount of material the Applicant intends to be within the scope of these claims, the units are essential to the practice of this invention.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Shanowski whose telephone number is (703) 305-0560. The examiner can normally be reached on M-F, 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for unofficial communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Paul Shanowski  
January 8, 2001

  
GLENN K. DAWSON  
PRIMARY EXAMINER